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10/706,397	11/12/2003	Sandeep Betarbet	190250-1460	6855
38823 7590 08/05/2008 THOMAS, KAYDEN, HORSTMAYER & RISLEY, LLP/ AT&T Delaware Intellectual Property, Inc. 600 GALLERIA PARKWAY, S.E. SUITE 1500 ATLANTA, GA 30339-5994				
EXAMINER				
BENGZON, OREG C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/706,397

Applicant(s)

BETARBET, SANDEEP

Examiner

GREG BENZON

Art Unit

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11,13-19,21-25 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11,13-19,21-25 and 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/19/2007, 07/16/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: _____

DETAILED ACTION

This application has been examined. Claims 1,3-11, 13-19, 21-25, 27-32 are pending. Claims 2, 12, 20, 26 are cancelled.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/21/2008 has been entered.

Priority

The effective date of the claims described in this application is November 12,2003.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 07/16/2008 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,3-11, 13-19, 21-22, 24-25, 27-32 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1,10,19, 24 recite limitations for 'allowing transfer of said at least one file to the remote host without necessitating a local presence of the remote host on the terminating file transfer server.'

The Examiner notes that there is insufficient guidance in the Applicant Specifications (Pages 16, 18) regarding said limitation. The claim language is ambiguous and is subject to misinterpretation. A person of ordinary skill in the art would not be able to ascertain the meaning of said '*local presence*' and would not be able to ascertain the scope and bounds of said claim limitation.

For purposes of examination the Examiner interprets said '*local presence of the remote host*' as a remote user logged on into the terminating file transfer server.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1,3-9, 19,21-25, 27-32 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 19 are directed towards '*a file handling system*'. Upon inspection of the Applicant Specifications Page 10-11 the Examiner concludes said file handling system is comprised of nothing more than software components.

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material.

Claims 24-25, 27-32 pertain to '*a computer-readable storage medium*', which the Applicant Specifications (page 12) define as paper storage medium. The Examiner notes that said paper storage mediums do not cause any functional interrelationships among that data and the computing processes performed when utilizing that data and thus are non-functional descriptive material. Descriptive material, such as music,

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literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or composition of matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3-11, 13-19, 21-22, 24-25, 27-32 rejected under 35 U.S.C. 103(a) as being unpatentable over Persels (US Patent 7065547) in view of Hashem (US Patent 7155578).

Persels disclosed (re. Claim 1) a file handling system, comprising: a terminating file transfer server (Persels-Column 4 Lines 40-50, 'eFORWARD Server') operable to receive a file transfer message from an originating file transfer server, the file transfer message including details (Persels-Column 5 Lines 55-65, 'specify a partner to receive a message and, optionally, a process that is requested to be executed by the receiving

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partner's host on receipt of a message') about the transfer including a local user and at least one filename; an agent (Persels-Column 4 Lines 40-50, *'transfer protocol engine'*) operable to read the file transfer message, and direct the transfer of at least one file (Persels-Column 8 Lines 10-20) associated with said at least one filename to a home directory (Persels-Column 5 Lines 50-60, *'partner iBOX to receive message'*) associated with the local user;

and a configuration file residing in the home directory, (Persels-Column 7 Lines 10-20, *'administrative details pertaining to iBOX'*) and operable to instruct the agent to transfer said at least one file to a remote host.

Persels disclosed delivering a data transfer file to its destination according to a pre-assigned port number. Persels disclosed operational information found on a database. (Persels-Column 6 Lines 10-15, *'specified IP address and listening port'*, Column 7 Lines 35-55, *'operational data'*) Persels further disclosed that to complete the data transfer the destination host name (Persels-Column 8 Lines 20-30) and port number must be specified. (Persels-Column 9 Lines 45-55)

However Persels did not disclose the agent further configured to transfer the at least one filename in accordance with instructions from a configuration file residing in the home directory wherein the configuration file comprises a host name and a port name of the remote host *thereby allowing transfer of said at least one file to the remote*

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host without necessitating a local presence of the remote host on the terminating file transfer server.

For purposes of examination the Examiner interprets said 'local presence' as a remote user logged on into the terminating file transfer server.

Hashem disclosed (re. Claim 1) an agent further configured to transfer the at least one filename in accordance with instructions from a configuration file residing in the home directory wherein the configuration file comprises a host name and a port name of the remote host (Hashem-Column 11 Lines 30-55, Column 12 Lines 5-55) thereby allowing transfer of said at least one file to the remote host without necessitating a local presence of the remote host on the terminating file transfer server. (Hashem-Column 5 Lines 25-55)

Hashem automatically download files to the destination user without requiring the destination user to login to the terminal file server.

Persels and Hashem are analogous art because they present concepts and practices regarding data transfer file handling using transfer agents. At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Hashem into Persels. The motivation for said combination would have been to provide data transfer processing with limited manual intervention. (Hashem-Column 3 Lines 40-55)

Persels-Hashem disclosed (re. Claim 3,13) wherein the remote host (Persels-Column 6 Lines 20-25,'iBOX DIRECT client') is associated with the local user. (Persels-Column 7 Lines 10-15,'allow user to create iBOX')

Persels-Hashem disclosed (re. Claim 4,14) wherein the originating file transfer server is operable to instruct the agent to execute upon receiving a file transfer message. (Persels-Column 5 Lines 55-65,' specify a partner to receive a message and, optionally, a process that is requested to be executed by the receiving partner's host on receipt of a message')

Persels-Hashem disclosed (re. Claim 5) wherein the agent is further operable to transmit said at least one file to the remote host. (Persels-Column 9 Lines 10-20,' If a destination client responds, then the message is immediately delivered and so marked in the eFORWARD Server database ')

Persels-Hashem disclosed (re. Claim 6,11) wherein the agent is further operable to delete said at least one file from the home directory in accordance with the configuration file. (Persels-Column 6 Lines 25-35,' message will be deleted once the retain period is over')

Persels-Hashem disclosed (re. Claim 7) wherein the terminating file transfer server is a Connect:Direct server. (Persels-Column 4 Lines 40-50, '*eFORWARD Server*'))

Persels-Hashem disclosed (re. Claim 8) a port monitor at the remote terminal operable to monitor communications to the remote host on a port specified by the configuration file. (Persels-Column 6 Lines 10-15, '*listening port*'))

Persels-Hashem disclosed (re. Claim 9) further comprising means for monitoring a port of the remote host for communications from the agent. (Persels-Column 6 Lines 10-15, '*listening port*'))

Persels-Hashem disclosed (re. Claim 10) a method of handling files on a Connect:Direct server, (Persels-Column 4 Lines 40-50, '*eFORWARD Server*')) comprising the steps of: receiving a file transfer message(Persels-Column 5 Lines 55-65, '*specify a partner to receive a message and, optionally, a process that is requested to be executed by the receiving partner's host on receipt of a message*') from an

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originating file transfer server; determining a home directory (Persels-Column 5 Lines 50-60, *'partner iBOX to receive message'*) from a local user associated with the file transfer message; storing at least one file associated with the file transfer message in the home directory; (Persels-Column 5 Lines 60-65, *'incoming message is preferably accepted and stored in the database 24 for forwarding'*) retrieving a configuration file from the home directory; and transmitting said at least one file responsive to the configuration file.

Persels-Hashem disclosed (re. Claim 11) wherein the method further comprises: responsive to the configuration file, removing the message from the home directory. (Persels-Column 6 Lines 25-35, *'message will be deleted once the retain period is over'*)

Persels-Hashem disclosed (re. Claim 14) further comprising using an agent program to direct the transfer of said at least one file to the home directory. (Persels-Column 5 Lines 60-65, *'incoming message is preferably accepted and stored in the database 24 for forwarding'*)

Persels-Hashem disclosed (re. Claim 15) further comprising using an agent program to transmit said at least one file responsive to the configuration file. (Persels-

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Column 6 Lines 10-15, '*specified IP address and listening port*', Column 7 Lines 35-40, '*operational data*')

Persels-Hashem disclosed (re. Claim 16.) using a Connect:Direct server to receive the file transfer message. (Persels-Column 4 Lines 40-50, '*eFORWARD Server*')

Persels-Hashem disclosed (re. Claim 17) monitoring a port at a remote terminal specified by the configuration file. (Persels-Column 6 Lines 10-15, '*specified IP address and listening port*', Column 7 Lines 35-40, '*operational data*')

Persels-Hashem disclosed (re. Claim 18) receiving said at least one file at the port specified by the configuration file. (Persels-Column 9 Lines 45-55)

Persels-Hashem disclosed (re. Claim 19) a Connect:Direct file handling system, comprising: a terminating file transfer server; an agent; and a configuration file; the terminating file transfer server being operable launch the agent upon receipt of a file transfer message, the file transfer message comprising a local and at least one filename, username (Persels-Column 8 Lines 5-20) and the agent being operable to direct the transfer of at least one file associated with the filename to a home directory

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associated with the username, the agent being further operable to read the configuration file, (Persels-Column 6 Lines 10-15, '*specified IP address and listening port*', Column 7 Lines 35-40, '*operational data*') and transfer said at least one file to a remote host specified by the configuration file.

Persels-Hashem disclosed (re. Claim 21), wherein the agent is operable to remove said at least one file from the home directory after transferring said at least one file to the remote host. (Persels-Column 6 Lines 25-35, '*message will be deleted once the retain period is over*')

Persels-Hashem disclosed (re. Claim 22) a port monitor at a remote host, the port monitor being operable to monitor a port specified in the configuration file (Persels-Column 6 Lines 10-15, '*specified IP address and listening port*')

Persels-Hashem disclosed (re. Claim 24) a computer readable medium having a program for handling files on a Connect:Direct server, the program operable to perform

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the steps of: receiving a file transfer message from an originating file transfer server; determining a home directory from a local user associated with the file transfer message; storing at least one file associated with the file transfer message in the home directory; retrieving a configuration file from the home directory; and transmitting said at least one file responsive to the configuration file. (See Claims 1,10)

Persels-Hashem disclosed (re. Claim 25), the program further operable to perform the step of: responsive to the configuration file, removing the message from the home directory. (Persels-Column 6 Lines 25-35, '*message will be deleted once the retain period is over*'))

Persels-Hashem disclosed (re. Claim 27) wherein the remote host is associated with the local user. (Persels-Column 7 Lines 10-15, '*allow user to create iBOX*'))

Persels-Hashem disclosed (re. Claim 28) the program further operable to perform the step of using an agent program to direct the transfer of said at least one file to the home directory. (Persels-Column 5 Lines 60-65, '*incoming message is preferably accepted and stored in the database 24 for forwarding*'))

Persels-Hashem disclosed (re. Claim 29) using an agent program to transmit said at least one file responsive to the configuration file. (Persels-Column 6 Lines 10-15, '*specified IP address and listening port*', Column 7 Lines 35-40, '*operational data*')

Persels-Hashem disclosed (re. Claim 30) using a Connect:Direct server to receive the file transfer message. (Persels-Column 4 Lines 40-50, '*eFORWARD Server*')

Persels-Hashem disclosed (re. Claim 31) monitoring a port at a remote host specified by the configuration file. . (Persels-Column 6 Lines 10-15, '*specified IP address and listening port*', Column 7 Lines 35-40, '*operational data*')

Persels-Hashem disclosed (re. Claim 32) receiving said at least one file at the port specified by the configuration file. (Persels-Column 6 Lines 10-15, '*specified IP address and listening port*', Column 7 Lines 35-40, '*operational data*')

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23 rejected under 35 U.S.C. 103(a) as being unpatentable over Persels (US Patent 7065547) in view of in view of Hashem (US Patent 7155578) in view of what was well-known in the networking art.

Persels-Hashem disclosed (re. Claim 23) a file processor located at the remote terminal, the file processor being operable to receive files via the port monitor. (Persels-Column 9 Lines 10-20, '*If a destination client responds, then the message is immediately delivered and so marked in the eFORWARD Server database*')

While Persels-Hashem substantially disclosed the claimed invention Persels-Hashem did not disclose (re. Claim 23) the file processor being operable to assign said at least one filename to said at least one file received, respectively.

At the time of the invention it would have been well-known in the networking art to include a rename function in a file processing system. (See Campbell US Publication 2005/0086298, Paragraph 254-257) At the time of the invention it would have been

obvious to incorporate a rename function into the system and method by Persels-Hashem. The motivation for said combination would have been to enable a user to indicate a preferred (e.g. more easily remembered) file name.

Response to Arguments

Applicant's arguments filed 05/21/2008 have been considered but they are not persuasive.

The Applicant presents the following argument(s) *[in italics]*:

Persels does not disclose that a configuration file residing in a home directory comprises a host name and port name of the remote host where a file is transferred.

The Examiner respectfully disagrees with the Applicant.

Persels disclosed delivering a data transfer file to its destination according to a pre-assigned port number. Persels disclosed operational information found on a database. (Persels-Column 6 Lines 10-15, '*specified IP address and listening port*', Column 7 Lines 35-55, '*operational data*') Persels further disclosed that to complete the data transfer the destination host name (Persels-Column 8 Lines 20-30) and port number must be specified. (Persels-Column 9 Lines 45-55)

With such disclosure from Persels it would have been obvious to include the host name along with the port number as part of the operational information associated with the destination inbox.

However in an effort to expedite prosecution the Examiner presents prior art by Hashem regarding this limitation.

Hashem disclosed (re. Claim 1) *an agent further configured to transfer the at least one filename in accordance with instructions from a configuration file residing in the home directory wherein the configuration file comprises a host name and a port name of the remote host.* (Hashem-Column 11 Lines 30-55, Column 12 Lines 5-55)

The Applicant presents the following argument(s) *[in italics]*:

... neither Persels nor Hashem describes that a file received at an inbox is transferred to a home directory in accordance with directions residing at the inbox by an agent residing at the inbox. For example, Hashem describes that a remote process downloads a file found in an external inbox.

The Examiner respectfully disagrees with the Applicant. Hashem disclosed a set of instructions for files in an internal inbox. (Hashem-Column 11 Lines 35-45).

Furthermore Hashem disclosed *allowing transfer of said at least one file to the remote host without necessitating a local presence of the remote host on the terminating file transfer server.* (Hashem-Column 5 Lines 25-55)

The Applicant presents the following argument(s) [*in italics*]:

Applicant respectfully traverses this finding of well-known features as described in Claim 23.

The Examiner respectfully disagrees with the Applicant. At the time of the invention the renaming of downloaded files were well-known in the networking art, as evidenced by Campbell US Publication 2005/0086298, Paragraph 254-257.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to the enclosed PTO-892 form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Bengzon whose telephone number is (571) 272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571)272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greg Bengzon/
Examiner, Art Unit 2144